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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,963	04/18/2001	Marcia L. Peters	RSW920010014US1	8479
<div>7590 04/27/2007 Esther H. Chong, Esquire Synnestvedt & Lechner LLP 2600 Aramark Tower 1101 Market Street Philadelphia, PA 19107-2950</div>			<div>EXAMINER CHAMPAGNE, DONALD</div>	
			<div>ART UNIT 3622</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/836,963

Applicant(s)

PETERS ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At independent claim 1, lines 3-4, and similarly in independent claims 9 and 18, "collecting group data passively from communication-enabled wireless communication devices and products", is an improper Markush group (MPEP § 2173.05(h)I). It is not clear whether "devices and products" is a joint limitation or a limitation in the alternative.

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-10, 12-14, 16-19 and 21-23 are rejected under 35 U.S.C. 102(e) as being obvious over Boyd (US006484148B1).

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6. Boyd teaches (independent claims 1, 9 and 18) a method, system and computer program product for providing targeted advertising to a group of individuals, the method comprising the steps of:

collecting group data (the *abbreviated profile code*, col. 9 lines 9-11 and 21-24) passively from communication-enabled wireless communication devices and products (*cellular telephones and the like ... beepers, handheld computers ...*, col. 8 lines 9-22, any of which read on a "device" and a "product", para. 14-16 below) present in an advertising area (col. 5 lines 9-13 and 28-35);

selecting advertisements to be displayed based on the collected group data only for communication-enabled wireless communication devices and products present in the advertising area at the time of display (col. 8 lines 34-45); and

displaying the selected advertisements on an electronic display device located in the advertising area to provide targeted advertising (col. 3 lines 52-54 and 60-63, and col. 4 lines 50-65).

7. Boyd also teaches at the citations given above claims 4-6, 12-14, 21 and 22.
8. Boyd also teaches: claims 2, 10 and 19 (col. 5 lines 65-66); and claims 7, 8, 16, 17 and 23 (col. 9 line 35 to col. 10 line 5).
9. Claims 3, 11, 15 and 20 are rejected under 35 U.S.C. 103(a) as obvious over Boyd.
10. Boyd does not teach Bluetooth technology (claims 3, 11 and 20). However, Boyd does teach imbedding a profile code in the personal communication device's signal (col. 9 lines 21-23), which accomplishes some of the purposes of Bluetooth technology. Because Bluetooth technology was a well-known means at the time of the invention for facilitating communication among wireless devices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Bluetooth technology to the teachings of Boyd.
11. Boyd does not teach (claim 15) that the data collector and the advertisement selector are located remote from the display device. Because it would provide economies of scale, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd that the data collector and the advertisement selector be located remote from the display device.

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12. Claims 24-26 are rejected under 35 U.S.C. 103(a) as obvious over Boyd in view of Francella ("RFID: The Next Generation", *Convenience Store News*, January 1999).
13. Boyd does not teach that the products comprise passive tags. Francella teaches products comprising passive tags (p. 4/5, 4th para. from the bottom). Because Boyd teaches that a broad variety of signal sources can be used (col. 8 lines 9-11), and because Francella teaches that the tags are ideal for acquiring targeted marketing data (p. 3/5), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Francella to those of Boyd.

Response to Arguments

14. Applicant's arguments filed with an amendment on 23 February 2007 have been fully considered but they are not persuasive. Applicant argues, "First, nothing in Boyd teaches or suggests collecting data passively from *products* of any kind." (Page 10, center para., emphasis in the original.) This depends on the interpretation of "products".
15. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
16. The instant application contains no such clear definition for the word "products". The phrase is used in the specification to denote anything that one might use or own.¹ That is how the examiner interprets "products", as anything that is produced and used or owned by consumers. The *cellular telephones* and *handheld computers* taught by Boyd (col. 8 lines 9-22) read on "products".

¹ For example, "product preferences" in para. [0014] and "consumer product" in para. [0015].

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17. Applicant also argues (pp. 10-11) that the spec. defines group data as data stored in the PDAs 20, and that group data is not obtained from a "third party source", as in Boyd. The spec. does define group data (para. [0014] and [0024]) as data collected from any local signaling device, including PDAs. However, Boyd does teach group data (the *abbreviated profile code*, col. 9 lines 9-11 and 21-24) which is taken from the signaling device, not from an outside database/third party source.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
21. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

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about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

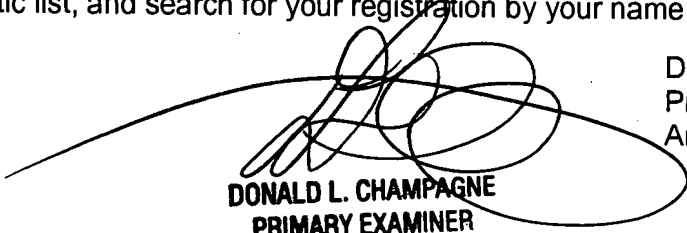
23. AFTER FINAL PRACTICE – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

24. Applicant may have after final arguments considered and amendments entered by filing an RCE.

25. ABANDONMENT – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

24 April 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622